



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/463,174	01/18/00	JAHODA	7260-1-001

HM12/0425

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WEBMAN, EXAMINER

ART UNIT	PAPER NUMBER
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04/25/01

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/463174

Applicant(s)

JAHODA

Examiner

WEBMAN

Group Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 01/18/00
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-36 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-36 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- *Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4,5
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 11-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicants claim dermal sheath tissue, which is a product of nature.

Claims 1-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 “comprised by” is indefinite; the preposition is grammatically improper. “can” is vague; under what conditions? It is unclear whether what follows “can” is definitely claimed.

In claims 6, 16, 24, 26 “suitable” and “suitably” are vague; the terms are subjective.

In claim 7 “functionally inserted” is indefinite; the adverb is unrelated to the verb.

In claims 9 and 10 “similar nature” and “different nature” are vague; they are subjective.

In claim 11 “arranged” is vague; what steps are taken?

In claims 12 and 14 “operationally linked” is vague; the adverb is unrelated to the verb.

In claim 15 “can be placed” is vague; under what condition?

In claims 17 and 18 “formulated” is vague; what formula?

In claims 19 and 20 “include” and “includes” are vague; the terms are non-limiting.

In claims 21, 22, 25, and 31 “adapted” is vague; what steps are taken?

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In claim 22 "so" is vague; what follows is not necessitated by what precedes the term.

In claims 23, 26, 34 and 36 "associated" is vague; it is subjective.

Claim 23 appears to be a statement rather than a description of the invention. Is "which" intended after "appliance" in line 1?

In claim 24 "accommodate" and "have the capacity" are vague; what follows is not definitely claimed.

In claim 26 "embedded" appears to be superfluous to "incorporated".

In claim 28 "highly complex" is subjective.

In claim 29 "extracellular matrix products" is vague and indefinite. What cells? Does the matrix produce a product?

In claims 34 and 36 "closely" is subjective.

In claim 34 "typically" is vague; what follows is not definitely claimed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by WO93/22430 (WO '430) and applicants' disclosure, page 10 line 6. .

WO '430 teaches a vector with sites for insertion for insertion of genes (abstract).

Applicants further disclose the commercially available Introgen vector which possesses such sites.

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Claims 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. On page 22 lines 1-9 and on page 28 line 27-page 29 line 14, applicants transfection of dermal sheath tissue with a vector containing a gene, namely the Invitrogen vector containing the eGFP gene. Applicants do not disclose transfection with the Invitrogen vector without the eGFP gene and later insertion of the gene into the vector after transfection (an apparently senseless procedure).


Claims 16-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Nowhere in the specification does applicant disclose the how to make the claimed compositions containing dermal sheath tissue and the claimed carriers..

Claim 24-36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Nowhere in the specification do applicants disclose how to make dermal sheath tissue altered so as to make it more susceptible to transfection. (Applicants do disclose how to make transfected dermal sheath tissue.)

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Claims 25-36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Nowhere in the specification do applicants disclose how to make the claimed wound healing system, nor do they disclose how to make the particular matrices containing a gene therapy vehicle.

No claims allowed.



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